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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/095,325	06/10/1998	GENE EGGLESTON	214149US25DIV	9524

22850   7590   06/05/2007
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER
WINDER, PATRICE L

ART UNIT	PAPER NUMBER
2145	

NOTIFICATION DATE	DELIVERY MODE
06/05/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
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jgardner@oblon.com

PTOL-90A (Rev. 04/07)

Interview Summary	Application No.	Applicant(s)
	09/095,325	EGGLESTON ET AL.
	Examiner	Art Unit	
	Patrice Winder	2145	

All participants (applicant, applicant's representative, PTO personnel):

(1) *Patrice Winder*.

(3)*W. Todd Baker*.

(2) *Jason Cardone*.

(4)*Gene Eggleston (inventor)*.

Date of Interview: *17 May 2007*.

Type: a)☐ Telephonic   b)☐ Video Conference
c)☒ Personal [copy given to: 1)☐ applicant   2)☐ applicant's representative]

Exhibit shown or demonstration conducted: d)☐ Yes   e)☒ No.
If Yes, brief description: _____ .

Claim(s) discussed: *56*.

Identification of prior art discussed: *Pepe*.

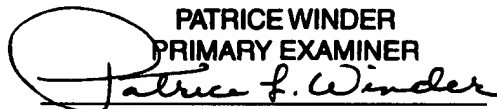Agreement with respect to the claims f)☐ was reached.   g)☒ was not reached.   h)☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: *See Continuation Sheet*.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

PATRICE WINDER
PRIMARY EXAMINER

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The interview was also attended Charles L. Gholz, Brad Murray from Motorola and Richard Sonnentag from Motorola. As per claim 56, Applicant argues that Pepe does not specifically teach the claim limitation "configures the received message .. thereby allowing messages ... associated with the host system." Applicant supported the argument with a characterization of the Pepe reference focusing on Figure 19. Specifically, Applicant focused on the purpose of Pepe's invention providing a mobile service subscriber the ability to remotely control the addressability, routing, accessibility and delivery messaging options, which is different from Applicant's invention. Applicant also argued that Pepe's PCI server is more analogous to Applicant's "protocol translator". Thus, Pepe does not teach the "configures" feature. This lead to a discussion of the Examiner not understanding the meaning of the terms "configures" and "appear". The examiner noted Applicant argues the limitation in whole which does not allow her to discern the deficiency of the Pepe reference. Nor can she determine what element of the claim limitation Pepe is missing or where she has made an error in the rejection. She suggested that Applicant address a specific element such as the host system, the mobile client or sender address which is not taught. As for the meaning of "appears", Applicant felt the Board of Appeals decided the meaning. See attached presentation entitled "Pending claims 56-63 and 65-68 of Application number 09/095,325 - Eggleston v. US 5,742,668 - Pepe". The remainder of the interview focused on the previously filed affidavit and the associated deficiencies. Applicant clarified that the intent was to show reduction to practice not conception. The examiner suggested that a sufficient affidavit could be filed were Applicant to correlate the claim limitations to the exhibits. The interview concluded with the presentation entitled "AirMobile Overview". Motorola's AirMobile product is being used to establish reduction to practice.
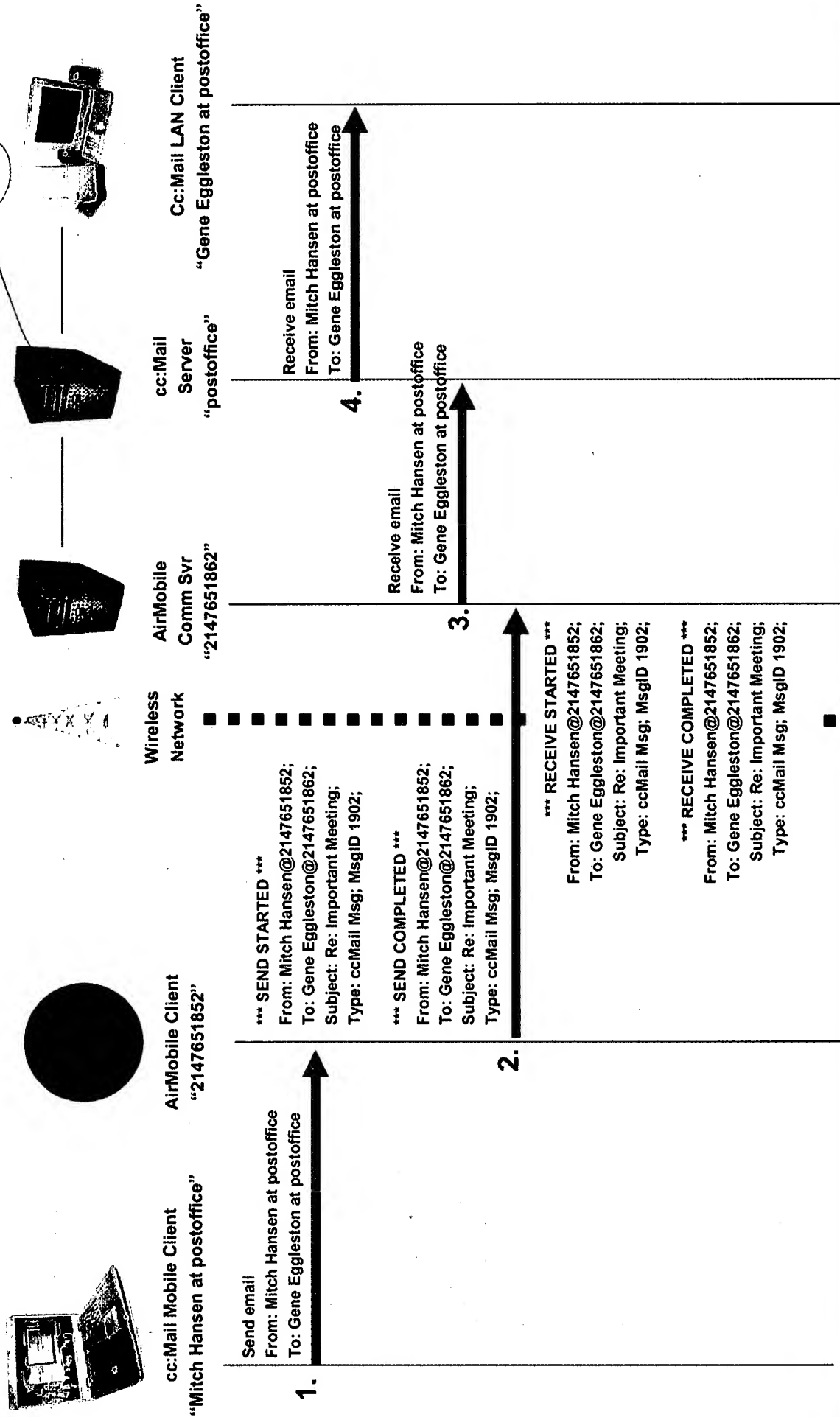
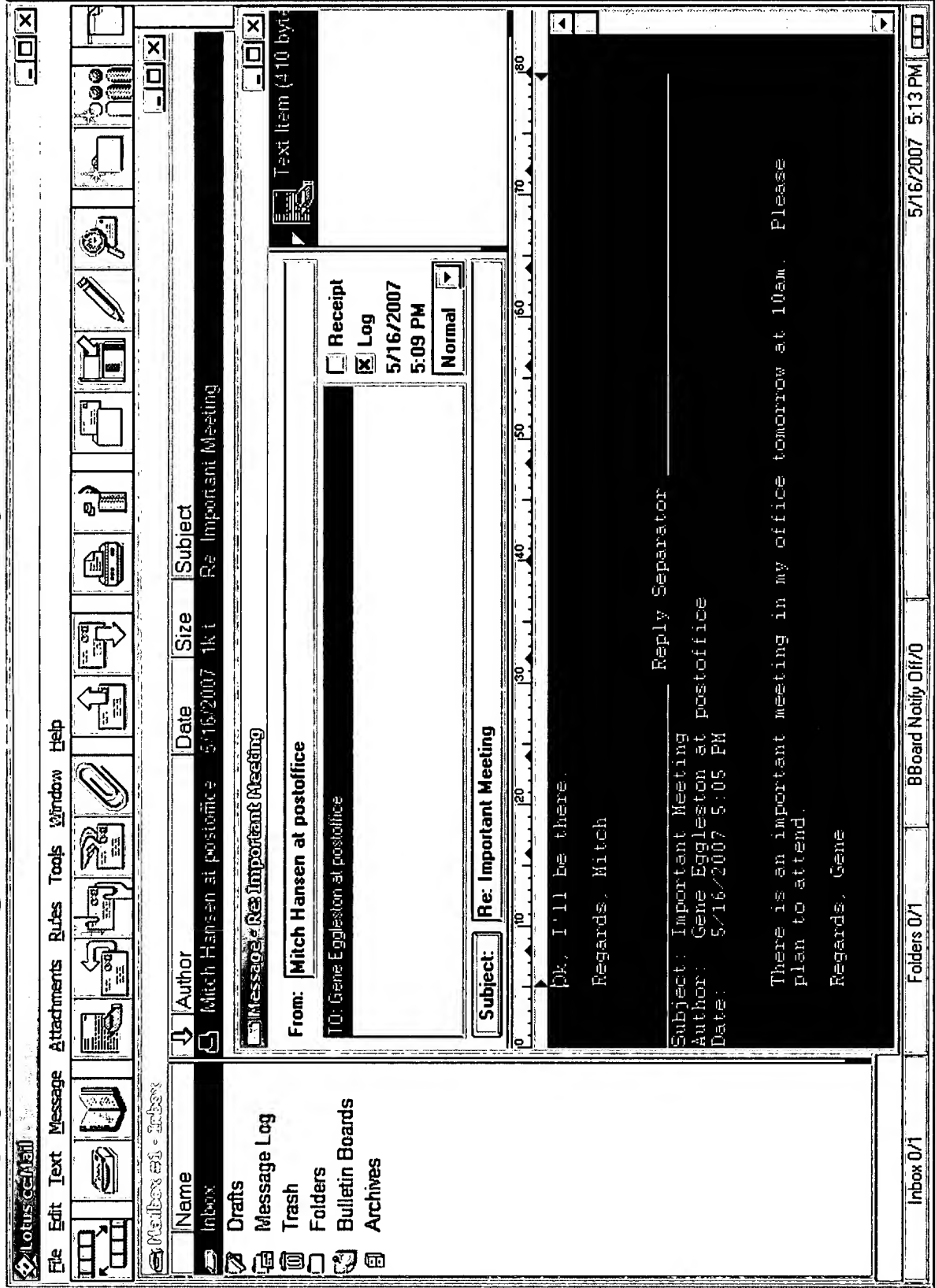# AirMobile Overview

Gene Eggleston

MOTOROLA intelligence everywhere™

AirMobile Message Flow Sequence Chart (Mobile to LAN)

cc:Mail Mobile Client
"Mitch Hansen at postoffice"

AirMobile Client
"2147651852"

Wireless Network

AirMobile Comm Svr
"2147651862"

cc:Mail Server
"postoffice"

Cc:Mail LAN Client
"Gene Eggleston at postoffice"

1.

Send email
From: Mitch Hansen at postoffice
To: Gene Eggleston at postoffice

2.

*** SEND STARTED ***
From: Mitch Hansen@2147651852;
To: Gene Eggleston@2147651862;
Subject: Re: Important Meeting;
Type: ccMail Msg; MsgID 1902;

*** SEND COMPLETED ***
From: Mitch Hansen@2147651852;
To: Gene Eggleston@2147651862;
Subject: Re: Important Meeting;
Type: ccMail Msg; MsgID 1902;

*** RECEIVE STARTED ***
From: Mitch Hansen@2147651852;
To: Gene Eggleston@2147651862;
Subject: Re: Important Meeting;
Type: ccMail Msg; MsgID 1902;

*** RECEIVE COMPLETED ***
From: Mitch Hansen@2147651852;
To: Gene Eggleston@2147651862;
Subject: Re: Important Meeting;
Type: ccMail Msg; MsgID 1902;

3.

Receive email
From: Mitch Hansen at postoffice
To: Gene Eggleston at postoffice

4.

Receive email
From: Mitch Hansen at postoffice
To: Gene Eggleston at postoffice

MOTOROLA

intelligence **(M)** *everywhere*

Mitch's reply message as received by Gene

Lotus cc:Mail

File Edit Text Message Attachments Rules Tools Window Help

Mailbox as - Inbox

Name
Inbox
Drafts
Message Log
Trash
Folders
Bulletin Boards
Archives

	Author	Date	Size	Subject
	Mitch Hansen at postoffice	5/16/2007	1k	Re: Important Meeting

Message - Re: Important Meeting

From: Mitch Hansen at postoffice

TO: Gene Eggleston at postoffice

☐ Receipt
☒ Log
5/16/2007
5:09 PM
Normal

Text Item (410 byt

Subject: Re: Important Meeting

Ok, I'll be there.

Regards, Mitch

————————— Reply Separator —————————

Subject: Important Meeting
Author: Gene Eggleston at postoffice
Date: 5/16/2007 5:05 PM

There is an important meeting in my office tomorrow at 10am. Please
plan to attend.

Regards, Gene

Inbox 0/1   Folders 0/1   BBoard Notify Off/0

AirMobile Client

- AirMobile Profiler Utility -

File Edit Help

[User Name at PostOffice Name]
Mitch Hansen at postoffice

Maps to/from

[User Name @ Local Radio ID]
Mitch Hansen@2177651852

General Information

User Name   Mitch Hansen   ● Enable   ○ Disable

User Password   *

PostOffice Name   postoffice

PostOffice Path   c:\ccmobile\ccdata1   ☑ Text Attach

Msg Truncation   ☑ File Attach

Remote Radio ID   2147651862

Local Radio ID   2147651852

Address of AirMobile Server

Ready

NUM

AirMobile Server

[User Name at PostOffice Name]
Mitch Hansen at postoffice

Maps to/from

[User Name @ Remote Radio ID]
Mitch Hansen@2147651852

Address of AirMobile Server
(same as the Remote Radio ID (e.g. 2147651862) shown in AirMobile Client)

File **Edit** **Help**

- AirMobile Profiler Utility -

General Information

Field	Value
User Name	Mitch Hansen
User Password	*
PostOffice Name	postoffice
PostOffice Path	C:\CCDATA
Msg Truncation	
Remote Radio ID	2147651852
Local Radio ID	2147651862

○ Enable
○ Disable

☑ Text Attach
☑ File Attach

Ready

NUM

Pending claims 56-63 and 65-68 of
Application Number 09/095,325 -
Eggleston

v.

US 5,742,668 – Pepe

Understanding the "transparency" feature

➢ From the decision of the Board of Appeals and Interferences, Appeal No. 2003-2074, page 8:

○ "With regard to claims 33-68, the examiner complains that there is no 'explicit' recitation in the specification for the now-claimed transparency, i.e., that the message recipients are unaware that the reply messages originated at a first address associated with the host system, rather than at the host system itself."

Representative language from the rejected independent claims

➤ Claim 56

➤ A computer system for forwarding messages from a mobile client comprising:

a host system capable of sending and receiving messages, wherein a message sender's email address is associated with the host system;

a forwarding component operable with the host system that upon receiving a message generated at the mobile client, by a message sender destined for a message recipient, configures the received message, prior to forwarding to the message recipient, such that the received message appears to the message recipient as if the received message originated at the sender's email address associated with the host system, thereby allowing messages generated at either the mobile client or host system to appear to originate at the sender's email address associated with the host system.

(AA) MOTOROLA

Representative language from the rejected independent claims

➤Claim 60

➤A method for forwarding messages generated at a mobile client by a message sender destined for a message recipient, comprising the steps of:

receiving a message, generated at the mobile client by the message sender destined for the message recipient, at a forwarding component associated with a host system, wherein messages generated at the host system by the message sender use a first address;

configuring the received message such that the received message appears to the message recipient as if the received message originated at the sender's first address, wherein messages generated at either the mobile client or host system appear to originate at the message sender's first address; and

forwarding the configured received message to the message recipient.

Representative language from the rejected independent claims

> Claim 65

> A computer readable medium encoded with software instructions for enabling a method of forwarding messages generated at a mobile client by a message sender destined for a message recipient, the method comprising the steps of:

receiving a message, generated at the mobile client by the message sender destined for the message recipient, at a forwarding component associated with a host system, wherein messages generated at the host system by the message sender use a first address;

configuring the received message such that the received message appears as if it were generated at either the mobile client or host system; and

forwarding the configured received message to the message recipient.

From the final rejection dated 04/23/2007

➢ Page 2-3:

➢ "3. Regarding claim 56, Pepe taught a computer system for forwarding messaged from a mobile client (abstract) comprising: a host system capable of sending and receiving messages, wherein a message sender's email address is associated with host system (column 5, lines 7-13; column 18, lines 1-16); a forwarding component operable with the host system that upon receiving a message generated at the mobile client, by a message sender destined for a message recipient (column 18, lines 16-20), configures the received message, prior to forwarding to the message recipient, such that the received message appears to the message recipient as if the received message originated at the sender's email address associated with the host system (conversion of source addresses at PCI, column 24, lines 27-31), thereby allowing messages generated at either the mobile client or host system to originate at the sender's email address associated with the host system (messages generated by mobile client are routed at PCI server and PCI generates converted messages at PCI, column 24, lines 27-31)....

➢ 7. The language of claims 60-63 65 is substantially the same as previously rejected claims 56-59 above. Therefore, claims 60-63, 65 are rejected on the same rationale as previously rejected claims 56-59."

Cites from Pepe noted by the Examiner

➢ Column 5, lines 7-13:

  ➢ "A consumer, an office for example, has various messaging equipment, such as a voice mail system 20, an e-mail terminal 22, fax machines 24, and telephones 26. These are all connected to wireline networks 29. For example, the e-mail terminal 22 may be connected to a data packet network, such as Internet, whose packets are carried over phone lines." NO TRANSPARENCY FEATURE DESCRIBED.

➢ Column 18, lines 1-16:

  ➢ "FIG. 14 is an illustrative example of a message flow sending an e-mail from a PDA 30 to a PCI server 48. When a subscriber sends an e-mail notification from the PDA 30, the PDA 30 forwards the e-mail notification to the PCI server 48. The body of the e-mail contains, for example, 'to;from;subject;cc' information (line 308). The PCI server acknowledges this notification (line 310). If the e-mail is longer than can be transmitted in a singled message, the PDA 30 segments the e-mail into multiple, sequentially numbered packets and sends them to the PCI server (lines 312, 316, 320). Each packet sent from the PDA is responded to with an acknowledgement containing the reception status of the message and the sequence number it is acknowledging (lines 314, 318, 322). The PDA 30 and PCI server 38 use the sequence number to maintain a sequential flow of packets." NO TRANSPARENCY FEATURE DESCRIBED.

Cites from Pepe noted by the Examiner

➢ Column 18, lines 16-20:

➢ "Out of sequence packets are discarded. Once all of the packets are received, the PCI server 48 puts them into their original order using the sequence number and forwards the now assembled e-mail to a message transfer agent, which then forwards the e-mail to the intended destination." NO TRANSPARENCY FEATURE DESCRIBED.

➢ Column 24, lines 27-31:

➢ "The translation from the 'user friendly' subscriber addresses such as E.164 numbering to the X.400 address would be done via a look-up table (ROM or other memory device) at the PCI access module or the X.400 gateway." NO TRANSPARENCY FEATURE DESCRIBED.

Conclusion regarding the Pepe reference

➢ THE PEPE REFERENCE DOES NOT TEACH OR OTHERWISE SUGGEST THE TRANSPARENCY FEATURE CLAIMED IN INDEPENDENT CLAIMS 56, 60 AND 65, NAMELY:

➢ [claim 56] THAT A "received message appears to the message recipient as if the received message originated at the sender's email address associated with the host system, thereby allowing messages generated at either the mobile client or host system to appear to originate at the sender's email address associated with the host system ...."

➢ [claim 60] "configuring the received message such that the received message appears to the message recipient as if the received message originated at the sender's first address, wherein messages generated at either the mobile client or host system appear to originate at the message sender's first address ...."

➢ [claim 65] "configuring the received message such that the received message appears as if it were generated at either the mobile client or host system ...."